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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,236	01/23/2004	Isao Toda	INA-0003	4509

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EXAMINER

DOAN, ROBYN KIEU

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/762,236	Applicant(s) TODA, ISAO	
	Examiner Robyn Doan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3/1,4/1,5,9/3/1 is/are rejected.
- 7) ☒ Claim(s) 2,3/2/1,4/2/1,6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/23/04,03/25/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4/1 and 9/3/1 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4/1 recites the limitation "said piles" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 9/3/1 recites the limitation "said piles" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa et al (U.S. Pat. # 5,573,822).

With regard to claim 5, Nishikawa et al discloses a heat-shrinkable tube (fig. 1) comprising a resin tube (2, col. 4, line 34) being capable of shrinking by heat, having a space, see fig. 1, through which natural hair and a hair thickening material can be inherently inserted, the resin tube also having an adhesive layer (1) which is disposed on an inner circumferential surface of the tube (abstract, lines 11-13); the adhesive being a thermoplastic resin (col. 4, lines 38-41). Applicant is noted that all the claimed structures have been shown, the intended use is not given patentable weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3/1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrington (IDS cited reference) in view of Arroyo et al (U.S. Pat. # 6,938,624).

With regard to claim 1, Barrington discloses a method of attaching a hair thickening material (figs. 3-5) comprising a step of inserting an own-hair into a hair thickening material fixture (30) from one end thereof (col. 4, lines 24-27), the fixture being in a form of a tube and can shrink by heating (col. 4, lines 29-30); Barrington also shows a step of inserting a hair material (22) into the hair-thickening fixture from the other end (fig. 4) and heating the hair thickening material fixture to allow it to shrink (col.

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4, lines 44-46). In regard to claim 3, Barrington further discloses the hair-thickening material being bundled at one end (32, fig. 3) by adhesive (col. 3, lines 62-65).

Barrington does not disclose the fixture being made of rubber or resin and having an adhesive layer of thermoplastic resin formed on an inner circumferential surface thereof.

Arroyo et al discloses a method of applying hair extensions to natural hair comprising a tube (40) through which a hair material (30) and natural hair (38) can be inserted, see fig. 19. The tube having an adhesive layer on an inner surface of the tube (col. 4, lines 16-26) it would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the adhesive layer as taught by Arroyo et al into the inner surface of the tube of Barrington for the purpose of providing aid in holding the hair material with the natural hair within the tube. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the fixture being made of rubber or resin and the adhesive layer being made of thermoplastic resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Allowable Subject Matter

Claims 2, 3/2/1, 4/2/1, 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4/1, 9/3/1 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: prior art of record such as Hudson (U.S. Pat. # 6,193,809) shows a piece of plastic material being substantially in a tube form comprising an inner circumferential surface which includes an adhesive layer and a large number of piles with hooked end; prior art of record fails to show the tube being made of rubber or resin, capable of shrinking by heating and the adhesive being made of thermoplastic resin.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Howell and Gang are cited to show the state of the art with respect to a method of attaching a hair thickening-material using a deformable tube.

The drawings filed 01/23/04 have been approved by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Dòan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robyn', with a long horizontal flourish extending to the right.

Robyn Doan
Examiner
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